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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,422	06/12/2001	Kurt Hoffmann	A-21421/A/CGM 432/DIV	6173

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

4

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 4

Office Action Summary

Application N .

09/879,422

Applicant(s)

HOFFMANN ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/160,000.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

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This application contains claims directed to the following patentably distinct species of the claimed invention:

Compound(s) (a) wherein if one or more are elected particular species thereof is/are identified.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 21-30 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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During a telephone conversation with Tyler A. Stevenson on September 9, 2002, a provisional election was made with traverse to prosecute the species of Irganox 1222 (diethyl-3,5-di-tert-butyl-4-hydroxybenzylphosphonate shown in Example A1 on page 64 of the specification, claims 21-23 and 26-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24 and 25 are withdrawn from further consideration under 37 CFR 1.142(b) as being drawn to non-elected species.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molenaar et al. and European Patent No. 719,824 in view of Great Britain Patent No. 1,358,637 and PCT Publication No. WO 94/29377.

Molenaar et al. discloses a dust-free granular blend (col. 3, lines 28-31) including epoxidized oils (col. 6, line 66) prepared by extrusion through a thin perforated die (col. 3, lines 32-33) with a diameter of more than 8 mm (col. 3, lines 48-49) wherein the highest melting lubricant has a melting point of not above 80°C, thereby embracing an extrusion temperature of at least above 80°C.

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The European patent sets forth low-dust granules of plastic additives (page 2, lines 35-36) such as the elected species of phenol antioxidant of diethyl-3,5-di-tert-butyl-4-hydroxybenzylphosphonate (page 22, lines 17-18) and light stabilizers (col. 28, line 22) which are extruded at a temperature of preferably about 130°C (page 3, lines 41-42) forced through a nozzle or hole with a diameter of from 1-10 mm and chopping the extrudate to granules (page 3, lines 15-18).

The claimed solid bisphenol A diglycidyl ether b) is not recited. The British patent teaches a stabilizer system comprising an organic phosphite, a polyhydric phenol and an epoxy compound (page 1, lines 36-38) such as a bisphenol A diglycidyl ether (page 24, line 34, BIS E) which imparts a synergistic resistance to discoloration over any of the stabilizer components alone.

The PCT publication demonstrates a reduced melt flow rate (MFR) for a stabilizer blend containing an organic phosphite (page 22, line 11, C-1 and page 26, Table 6, Example 12) and bisphenol A diglycidyl ether (page 21, last line, A-3) versus a mixture without it (the Comparison with (B-1/C-1)).

It would have been obvious to incorporate the bisphenol A diglycidyl ether of the British and PCT patents as a stabilizer additive to the granular blends of Molenaar et al. and the European patent in order to augment the resistance to discoloration (British patent) and to reduce the melt flow rate (PCT publication).

The claims are directed to low-dust granules and not the process of their preparation, thereby constituting a product-by-process. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (*In re Thorpe*, 227 USPQ 964, 966, Federal Circuit 1985 and MPEP § 2113, the 'Product-by-Process Claims' section)." "Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (*In re Marosi*, 218 USPQ 289, 292, Federal Circuit 1983 and MPEP § 2113, the section entitled 'Once a Product Appearing to be Substantially Identical is Found and a 35 U.S.C. 102/103 Rejection Made, the Burden Shifts to the Applicant to Show an Unobvious Difference')." "

Although the extrusion temperature of between 80-120°C defined in claim 30 is not recited in Molenaar et al. and the European patent, the dust-free or low-dust granular blend containing the bisphenol A diglycidyl ether of the British patent and PCT publication renders the claimed low-dust granules obvious. There is no evidence establishing an unobvious difference between the claimed and prior art products with respect to the extrusion temperature range of claim 30 and the closest prior art value of 130°C espoused in the European patent.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pfaendner et al. describes granules (col. 5, lines 6-7) of an epoxy resin such as a diglycidyl ether of bisphenol A (col. 3, lines 55-56) and a particularly preferred diethyl-3,5-di-tert-butyl-4-hydroxybenzylphosphonate.

(703) 308-2399 (Fax no. (703) 872-9310)
Monday to Friday from 9:30 to 6:00 EST

A handwritten signature in black ink, appearing to read 'Robert Sellers', is positioned above the printed name.

Robert Sellers
Primary Examiner
Art Unit 1712

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9/9/02